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EXAMINER

JUBA JR, JOHN

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 05/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/671,674

Applicant(s)

KOMMA ET AL.

Examiner

John Juba

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2003 and 13 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-85,88,92,93,113,115,122,123,126,128 and 131-159 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

- 6) ☒ Claim(s) 1-85,88,92,93,113,115,122,123,126,128 and 131-159 is/are rejected.

- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.

- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) ☒ The proposed drawing correction filed on 22 January 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)

- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

- 5) ☐ Notice of Informal Patent Application (PTO-152)

- 6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on January 22 and February 13, 2003 have been entered.

### ***Information Disclosure Statement***

Applicants' I.D.S. filed January 22, 2003 has been fully considered. Japanese publication 06-325405 has been considered only as to the English-language abstract and sole published figure provided.

### ***Drawings***

The proposed drawing correction filed on September 27, 2000 has been approved by the examiner. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Applicants are reminded that the amended drawing must be presented with a legend identifying the drawing as having been "Amended". 37 CFR 1.173 (b) (3). Any

Art Unit: 2872

added figure must be identified as "New." In the event that a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled".

### ***Reissue Application Papers***

Applicants are reminded that the original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

### ***Specification***

The specification is objected to under 37 CFR 1.173 as being in improper form. In particular, the title on Page 1 of the instant application is not in proper form. As set forth in MPEP 1411.01, all changes made by Certificate of Correction should be presented without bracketing or underlining, so as to be considered part of the granted patent. If the matter corrected by the Certificate of Correction is to be further amended, then bracketing and underlining is appropriate to reflect the further amendment.

Applicants indicate that the title *as corrected by Certificate of Correction file May 23, 2003* has been amended. However, the title has been presented with bracketing and underlining added with respect to the title *as originally filed*, rather than as to the title as corrected by certificate. Upon reissue, the title of the invention must read as corrected by certificate, with any amendment to *that* title highlighted with bracketing and underlining.

***Reissue Declaration***

The reissue oath/declaration originally filed with this application and supplemented by the first "REISSUE APPLICATION SUPPLEMENTAL DECLARATION BY INVENTOR" (February 13, 2003) is defective because it fails to identify at least one error relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414. In particular,

(a) the first error relied upon is not identified with sufficient particularity as a determination can be made that the "error" is a *correctable* error under 35 U.S.C. § 251; and

(b) the second error relied upon is factually flawed.

Applicants' supplemental declaration states that the original patent is believed to be partially defective by reason of Applicants claiming less than they had the right to claim. Thus, (a) the issued claims are said to be narrower than they should be in view of the patent's disclosure and the prior art. In particular, at Pg. 2, sixth paragraph of the Supplemental Declaration, Applicants state

"it is my belief that this recitation of the invention is unduly narrowed by the presence of additional limitations found in the parent claim thereof and that the additional limitations were not added to the features of claim 14 to obtain allowance thereof".

However, Applicants have not identified *what* additional features are recited in the parent claim that unduly limit the scope of claim 14 in a manner that renders the claims partially inoperative in the context of § 251. The following is an excerpt from MPEP 1414 at II [original Eighth Edition, Aug. 2001, latest revision Feb. 2003]:

"It is not sufficient for an oath/declaration to merely state 'this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure.' Rather, the oath/declaration must specifically identify an error. In addition, it is not sufficient to merely reproduce the claims with brackets and underlining and state that such will identify the error. See *In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), cert. denied, 484 U.S. 894 (1987). *Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error.* [emphasis added].

Applicants need identify only one such error, but the error must be identified with sufficient specificity as would demonstrate that the error supports reissue. The examiner's findings with respect to patented claim 14 will be discussed later as it relates to further rejection of the claims.

Applicants identified further error (b), as to specific claims of Application serial number 08/455,934 (hereinafter, "the original patent application" or "the patented file") having been canceled. The statement of error is factually flawed (at Pg. 3 of the first Supplemental Declaration) in that Applicants rely upon claims 154, 173, 234, and 210 as having been "identified by the examiner as linking the structure of issued claim 1 to several other groups of claims". However, such is not the case. A review of the restriction requirement set forth in the patented file (paper #6; May 8, 1996) reveals that the examiner identified 13 patentably distinct inventions (groups I - XIII), wherein:

claim 154 was indicated as linking groups III and IV;

claims 173 and 234 were indicated as linking groups V, VI, and VII; and

claim 210 was indicated *not* as a linking claim, but as “not patentably distinct from” groups V, VI, or VII, and accordingly examinable with one of these groups if elected.

Applicants elected the invention of group I, with traverse, on June 6, 1997 (paper #8 of the patented file). Accordingly, it should be clear that *none* of the claims identified by Applicants was a linking claim that linked different inventions to the elected invention. Rather, it was claim 120, which finally matured into “Claim 1”, that was indicated as linking several inventions. [The examiner indicated that claim 120, *in its then-present scope*, linked the inventions of groups I – VII.]

Applicants further rely upon cancellation of claims 154, 173, 234, and 210 as having taken place “irrespective of Applicants’ directions to retain the claims”. However, such is *not* the case. Rather, these claims were *withdrawn* from consideration by the examiner, upon Applicants’ election. The claims were canceled by *Applicants’ express instruction* to do so on January 10, 1997 (paper #11 of the patented file).

Further, Applicants rely upon the notion that claims 154, 173, 234, and 210 along with claims 140, 148, 150, 155 – 168, 170 – 172, 174 – 209, and 211 – 214 variously dependent therefrom “would have been examined and allowed upon finding issued claim 1 allowable over the prior art”. However, such is not entirely the case, since

claims 155 – 168, and 170 – 172 depended from claim 154, which lacked the limitations of claim 120 that led to its issue as claim 1; and

claims 174 – 209 and 211 – 214 depended from claim 173, which lacked the limitations of claim 120 that led to its issue as claim 1.

Only claims 140, 148, and 150 depended from, or otherwise contained the limitations of issued claim 1. Claim 140 passed to issue as claim 14, depending from issued claim 1. Claim 148 was canceled by *Applicants' express instruction* to do so on January 10, 1997 (paper #11 of the patented file); claim 150 canceled by *Applicants' express instruction* to do so on October 27, 1997 (paper #19 of the patented file).

### ***Claim Rejections – 35 U.S.C. § 251***

Claims 1 – 85, 88, 92, 93, 113, 115, 122, 123, 126, 128, and 131 – 159 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

A supplemental declaration to obviate this rejection is required in response to this Office action, and cannot be deferred until the application is otherwise in condition for allowance. The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Independent claims 133, 154, 157, and claims 88, 92, 93, 113, 115, 122, 123, 126, 128, 131, 132, 134 – 153, 155, 156, 158, and 159 variously depending therefrom are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir.



1984). A broadening aspect is present in the reissue which was not present in the application for patent.

The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Independent claims 133, 154, and 157 relate to patented claim 11 as requiring light to be focused at a distance T1 from the surface of a first substrate or layer and requiring light to be focused at a second distance T2 from the surface of a second substrate or layer. Notably, the reissue claims and patented claim 11 require this focusing to be the result of features on a lens.

For reference, patented claim 11 is presented below in independent form. To avoid confusion, the preamble of parent claim 1 replaces that of claim 11, and the preambles of intervening claims 2 and 10 have been omitted without bracketing. Underlining is included to show the various limitations added to claim 11 with respect to its original form as claim 137 (depending from claims 120, 121, and 136) in the patent application.

11. (in independent form) [1.] A compound objective lens, comprising:

lens means, having a first convex surface and a second convex surface opposite to each other, for receiving [refracting] a beam of incident light [;] of one particular

Art Unit: 2872

wavelength passing through an optical axis at the first convex surface, refracting the beam of incident light and emitting a beam of refracted light from the second convex surface; and

plural focal point generating means for receiving the beam of incident light not yet refracted by the lens means, generating from the beam of incident light a plurality of beams of divided light including a first beam of divided light and a second beam of divided light, converging the beams of divided light [the incident light refracted by the lens means] at a plurality of focal points which are placed on the optical axis on a [on one] side facing the second convex surface of the lens means on condition that the first beam of divided light transmits through a first substrate and is converged on an information recording plane placed at a first distance T1 from a surface of the first substrate at a diffraction limit and that the second beam of divided light transmits through a second substrate and is converged on an information recording plane placed at a second distance T2 ( $T1 \neq T2$ ) from a surface of the second substrate at a diffraction limit

in which the plural focal point generating means is a hologram generating from the incident light as the beams of divided light a plurality of beams of diffracted light having different diffraction orders

in which a positional relationship between the lens means and the hologram is fixed

in which the hologram is formed on a lens surface of the lens means.

Although narrower in some respects, independent reissue claims 133, 154, and 157, are *broader* than original claim 137 by omission of limitations added to obtain a patent. Specifically, original claim 137 depended from independent claim 120 by way of intervening claims 121 and 136. In a first action on the merits (paper #9; September 12, 1996):

parent claim 120 was rejected under 35 U.S.C. §102(b) as being anticipated Freeman (U.S. Patent number 4,637,697), among other references;

parent and intervening claims 120 and 121 were rejected under § 102(b) as being anticipated by Hori, et al (U.S. Patent number 5,062,098);

intervening claim 121 was further rejected under § 103 as being unpatentable over Aoyama, et al (U.S. Patent number 5,122,903); and

claim 137 and intervening claim 136 were rejected under § 103 as being unpatentable over Freeman . . . I

The examiner apparently cited Freeman as evidence of the obviousness of providing the "plural focal point generating means" in the form of a hologram.

In response their response dated January 10, 1997 (paper #11), Applicants amended the base claim to recite "the lens means having a first convex surface and a second convex surface opposite to each other", and argued (at Pg. 10) that this feature distinguishes claim 120, "upon which all other non-cancelled claims depend," from Freeman (among other references). Claim 120 was further amended to require the plurality of focal points to be "on the optical axis on a side facing the second convex surface" of the lens means. Applicants argued that this feature distinguishes claim 120 from Aoyama (among other references).

Notably, it was further submitted (at the bottom of Pg. 11) that "the rejected claims, all of which are parented by claim 120, are patentably distinguishable of the applied art and applied art combinations *for the reasons discussed above in connection with the rejection of claims 120*" [emphasis added]. Applicants never argued that claims

Art Unit: 2872

121, 136, and 137 further distinguished over the prior art for their respective features, such as the provision of the plural focal point generating means on a lens surface of the lens means. Thus, Applicants effectively canceled the broader recitation of plural focal point generation by features on a lens surface where the lens was not required to have first and second opposing convex surfaces. That is, Applicants surrendered *at least* this broader aspect now presented in independent reissue claims 133, 154, 157, and claims 88, 92, 93, 113, 115, 122, 123, 126, 128, 131, 132, 134 – 153, 155, 156, 158, and 159 (variously depending therefrom).

In a subsequent Office action (paper #12; March 4, 1997), original claim 120 was rejected under § 102(b) as being anticipated by Marron, et al (U.S. Patent number 5,175,651). The examiner clarified that Applicants' previous amendment of original claim 120 distinguishes the claimed invention over Hori, et al. After a succession of miscommunications (paper #'s 14, 15, and 16), Applicants respond (paper #19; October 27, 1997) that the examiner "does concede that the amendment to claim 120 had overcome the rejection over Hori. *No further response is thus necessary with respect to this point*" [emphasis added; third whole paragraph, Pg. 10].

In order to distinguish over Marron, et al Applicants further amended claim 120 to limit the cooperation of the elements such that the plural focal point generating means receives light specifically "not yet refracted by the lens means", and generates "beams of divided light including a first beam of divided light and a second beam of divided light" and converges the "divided" light "on condition that the first beam of divided light transmits through a first substrate and is converged on an information recording plane

Art Unit: 2872

placed at a first distance T1 from a surface of the first substrate at a diffraction limit and that the second beam of divided light transmits through a second substrate and is converged on an information recording plane placed at a second distance T2 ( $T1 \neq T2$ ) from a surface of the second substrate at a diffraction limit". Applicants never argued the separate patentability of claims 136 and 137, and elected instead to have these claims further limited by the amendment to claim 120.

However, insofar as claims 136 and 137 (which matured into patented claim 11) were not rejected over Marron, et al, this broader aspect of independent reissue claims 133, 154, and 157 (with respect to patented claim 11), may not have been surrendered in order to obtain a patent.

Finally, original claims 120, 122, and 136 (among others) were rejected under § 103 as being unpatentable over Russell (EP 0 486 060) in paper # 20 (December 4, 1997). Claim 137 was rejected under § 103 as being unpatentable over Russell in view of Yokoyama (U.S. Patent number 5,161,040) or Braat (U.S. Patent number 4,986,641). In response, Applicants narrowed claim 120 and its dependent claims to particularly recite that the incident light is "of one particular wavelength" and argue that this feature distinguishes over Russell in that the "plurality of focal points, at which the beams of divided light are converged, correspond to the same particular wavelength" [emphasis in original]. Again, Applicants never argued the separate patentability of dependent claims 122, 136, and 137. Thus, it is believed that Applicants have surrendered this broader aspect of independent reissue claims 133, 154, and 157 with respect to claim 137 which matured into patented claim 11. Thus, independent reissue

Art Unit: 2872

claims 133, 154, 157, and claims 88, 92, 93, 113, 115, 122, 123, 126, 128, 131, 132, 134 – 153, 155, 156, 158, and 159 (variously depending therefrom), by omission of this “one particular wavelength” limitation, impermissibly seek to recapture subject matter canceled to obtain a patent.

Having set forth the history of prior art rejections, it is convenient to revisit an aspect of Applicants’ Reissue Declaration and the first supplement thereto. Applicants point to an aspect of the invention which is believed to have been unduly narrowed during the prosecution of the patented application. At Page 2 (sixth paragraph) of the first Supplemental Declaration, Applicants comment that patented claim 14 was unduly narrowed by “the presence of additional limitations found in the parent claim thereof” and opine that “the additional limitations were not added to the features of claims 14 to obtain allowance thereof”.

The examiner now identifies original claim 140 of the patented application as having matured into patented claim 14. “Claim 140” was originally withdrawn from consideration by the examiner as having been directed to the non-elected invention of group II. In response to the first Office action on the merits (paper #9), Applicants canceled most of the claims drawn to non-elected inventions, but retained claims 140 and 150 of group II. As set forth above, Applicants argued (paper #11), that the narrowing of claim 120 (from which claim 140 depended) distinguishes claim 120, “upon which all other non-cancelled claims depend,” from Freeman (among other references). Further narrowing aspects of claim 120 were argued as distinguishing claim 120 from Aoyama (among other references).

Although claim 140 was not rejected over prior art, Applicants clearly retained claim 140 to preserve the subject matter thereof, while at the same time, narrowed the subject matter thereof to obtain a patent for the base claim.

In subsequent Office actions, the examiner neglected to indicate (in the Office action summary form PTO-326) that claims 140 and 150 were still pending, but withdrawn from consideration. In response to Applicants' request for clarification (paper #13; June 4, 1997), and through a series of miscommunications (paper #'s 14, 15, and 16), the examiner listed claims 140 and 150 as being among the rejected claims, but failed to indicate specific grounds of rejection for these claims.

In their response of October 27, 1997 (paper # 19), Applicants overcame the rejection of rejection of claim 120 as being anticipated by Marron, et al, by canceling claim 150 and inserting the subject matter thereof into claim 120, and by arguing that this further limitation was neither taught nor suggested by Marron, et al.

Although claim 140 was still not rejected over prior art, Applicants clearly retained claim 140 to preserve the subject matter thereof, while at the same time, narrowed the subject matter thereof to obtain a patent for the base claim.

Realizing that claims 140 and 150 had effectively been rejoined, and appreciating that claim 120 linked the subject matter thereof, the examiner issued a rejection of claims 120 and 140, among others as being unpatentable over Russell (paper # 20; December 4, 1997).

In response (paper #21; March 4, 1998), Applicants narrowed the scope of the base claim to include the "one particular wavelength" limitation, and argued (at Pg. 4)

Art Unit: 2872

that this feature distinguished over Russell. Applicants never argued the separate patentability of claim 140, but instead narrowed the subject matter thereof in order to obtain a patent.

Thus, to the extend that independent reissue claims 133, 154, 157, and claims 88, 92, 93, 113, 115, 122, 123, 126, 128, 131, 132, 134 – 153, 155, 156, 158, and 159 (variously depending therefrom) relate to patented claim 14, the reissue claims, broadened by omission of this “one particular wavelength” limitation, impermissibly seek to recapture subject matter canceled to obtain a patent.

### ***Claim Objections***

Claim 136 is objected to because of the following informalities. Appropriate correction is required:

In claim 136, “the optical disk” lacks antecedent basis.

### ***Claim Rejections - 35 USC § 112***

Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 is confusing or incorrect in reciting that the hologram is placed at an opposite position from the light source. As depending ultimately from claim 25, the hologram is part of the plural focal point generating means “for receiving the beam of incident light not yet refracted by the lens means”. The only recited beam of light is said



to radiate from the light source. Thus, it is not clear how the hologram can be on an opposite position of the lens means from the light source, and at the same time receive "the beam" of light from the source before it is refracted by the lens means.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 128, 131 – 134, 136, 137, 139, 140, 142, 144, 145, 148, 154, 156, 157, 159 are rejected under 35 U.S.C. 102(b) as being anticipated by Ono, et al (U.S. Patent number 4,945,529). Referring Figure 4 and the associated text (*esp.*, Col. 8, lines 55+), Ono, et al disclose the compound objective lens (49)(75) of claim 133. "Diffraction grating" (75) is disclosed as a hologram having regions which have focal power by virtue of the manner in which they were recorded. A first region can be identified as the more distant region from the optical axis, the second region is defined closer to the optical axis. The numerical aperture of the first (outermost) region is larger than that of the innermost region, as should be evident by inspection. The recitation of regions as having been "optimized" to accomplish a particular function is related to structure not part of the claimed combination. For example, with regard to claim 14, a recording medium *can be arranged* with the layers and thicknesses in the recited relation (the disk may need to be inverted with respect to the conventional arrangement).

With regard to claim 136, it appears that this claim is drawn to a larger combination of structure not positively recited. As set forth with respect to claim 134, prior art structure is inherently capable of such an arrangement.

With regard to claim 137, the examiner believes that one of ordinary skill would understand the "slits" of Ono, et al to be a relief structure.

With regard to claim 139, the hologram (75) fairly constitutes a partitioned lens.

With regard to claim 140, the assembly comprises objective lens(49) and a relief lens (75) on which the plurality of regions are provided.

With regard to claim 144, the slits have a curvature that may be regarded as a "slope" within the specificity recited. There inherently is a convex lens somewhere that can have its surface arranged substantially parallel to this slope.

With regard to claim 154, the recitation of the lens region as being "to produce a focal point through a layer" is believed to amount to a statement of intended use, and fails to distinguish over the prior art structure, which is *capable of* such use. As set forth above with respect to claim 133, the manner in which the regions were "optimized" to accomplish a particular function is not seen to distinguish over the prior art. The first and second layers are not positively recited as part of the combination, but rather recited as to the manner in which the apparatus is intended to be used.

With regard to claim 156, the disk is not positively recited as part of the combination, but rather as part of an intended use. Since the disk *can be* arranged to satisfy this limitation, this recitation fails to distinguish over the prior art. (It may be necessary to install the disk upside down.)

With particular regard to claim 159, the reference is relied upon for what it conveys to one of ordinary skill. One of ordinary skill would understand the disclosure of a compact disk apparatus as comprising a rotating apparatus. The moving apparatus is disclosed at least atop Column 6.

***Allowable Subject Matter***

Subject to their rejection under 35 U.S.C. § 251, claims 1 – 32 and 34 – 85 are allowable over the prior art of record. Claim 33 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Claims 88, 92, 93, 113, 115, 122, 123, 126, 135, 138, 141, 143, 146, 147, 149 – 153, 155, and 158 are objected to as being dependent upon a rejected base claim, but would be allowable over the prior art if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art, taken alone or in combination, fails to teach or to fairly suggest the plural focal point generating means receiving one particular wavelength and generating beams of divided light arranged with respect to first and second convex surface of the lens means, under the conditions particularly recited in claims 1, 25, and 44.

Art Unit: 2872

The prior art, taken alone or in combination, fails to teach or to fairly suggest, *in combination*, focusing *means* performing the function as particularly recited in claims 88, 92, 115, 122; or a focus controller *cooperating* as recited in claim 158.

Similarly, the prior art fails to teach or fairly suggest, *in combination*, the further provision of a photodetector *cooperating* as recited in claim 113;

the further provision of a ring-shaped phase shifting band, as recited in claims 123 and 126;

the provision of the optical relief formed *concentrically* in the second region, as recited in claim 135;

the provision of the regions with heights in the relationship recited in claim 138;

the arrangement of the first region such that the distance T1 is as recited in claim 141;

the hologram as having the diffraction efficiency as particularly recited in claims 143 and 149;

the provision of a region without a hologram, as recited in claims 146 and 147;

the relief structure having the height as particularly recited in claim 150;

the hologram as having the particular phase modulation degree as recited in claim 152; or

the provision of a collimator, as recited in claim 155.

### ***Response to Argument***

Applicants' request for reconsideration filed April 4, 2002 (paper #10) has been revisited. The examiner now concurs that the reissue declaration is *not* deficient in failing to address whether or not the claims are "entirely distinct" and/or failing to address whether or not *Weiler* is the controlling case law. There simply is no requirement to do so. Applicants' declaration alludes to error correctable under 35 U.S.C. §251, but is deficient only as to the specific aspects of the claims that render them inoperable.

Applicants are correct in noting that the claims presented are "for the invention disclosed in the original patent" as required by statute. However, as set forth in the rejections above, many of the claims are believed to seek impermissible recapture of surrendered subject matter.

It is noted that Applicants' have canceled claims 86, 87, and 105 – 112, variously directed to non-elected inventions of the original patent application. The impropriety of reissuing claims to non-elected inventions for which divisional application was not timely filed is believed to be a well-settled matter. Still, Applicants' amendment is noted with appreciation as materially reducing the issues for appeal.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Olmstead (U.S. Patent number 5,770,847) discloses a compound objective lens wherein the numerical aperture varies with focal length (e.g., Fig. 34). This reference is not prior art with respect to Applicants' effective filing date under 35 U.S.C. § 120. Copending application serial number 08/190,520 (Feb. 1, 1994), which matured into U.S. Patent number 5,446,565 has been reviewed and found to support the subject matter of at least independent claims 133, 154, and 157 (in the context of § 112, first paragraph) in the discussion of Figures 6, 10, and 21 of that patent.


Kato (U.S. Patent number 4,566,762) disclose a dual focus optical system relying upon birefringent elements. Notably, the birefringent element is not a "plural focal point generating *means for receiving the beam of incident light not yet refracted by the lens means*, [for] generating from the beam of incident light a plurality of beams of divided light including a first beam of divided light and a second beam of divided light, [for] *converging the beams of divided light at a plurality of focal points which are placed on the optical axis on a side facing the second convex surface of the lens means*". In their October 27, 1997 response (paper #19 of the patent application), Applicants argued that the claims must be construed properly in light of 35 U.S.C. §112, sixth paragraph.

Art Unit: 2872

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Juba whose telephone number is (703) 308-4812. The examiner can normally be reached on Mon.-Fri. 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on Mon.- Thu., 9 - 5. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

  
JOHN JUBA  
PRIMARY EXAMINER  
Art Unit 2872

May 5, 2003